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REMARKS

In accordance with the forgoing, claim 11 has been canceled and claims 1-11 have been amended; thus, claims 1-11 are currently pending and under consideration for substantive examination. The following remarks are respectfully submitted. Applicants request entry and favorable consideration of the amendments and remarks presented herein.

Claim Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 6-9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that a confusing statement in the body of independent claim 6 is not understood.

Applicants herein amend claim 6 to correct the lack of antecedent basis and respectfully suggest that claim 6 now is definite and precise and the ground of rejection has been overcome. Since claims 7-9 depend from claim 6, Applicants respectfully suggest that they too are now sufficiently definite and precise and the rejection withdrawn as to these claims as well as claim 6.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,615,347 issued to Davis et al. ("Davis"). According to the Examiner, Davis "discloses a software system that constraints [sic] certain parameters."

Applicants respectfully traverse the rejections as enumerated hereinbelow and herewith amend claims 1-9 to distinguish the presently claimed invention from Davis. For example, each independent claim now affirmatively recites a limitation requiring an "implantable medical device."

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"A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim."
Trintec Indus. Inc. v. Top-U.S.A. Corp., 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).
"Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Id.

In view of the differences identified above, Davis fails to anticipate the features claimed in the now amended claims and the rejection of claims 1-9 should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,345,362 to Winkler ("Winkler") in view of Davis. Finally, the Examiner rejected claim 12 as being unpatentable over Winkler in view of Davis and further in view of U.S. Pat. No. 5,491,782 to King et al. ("King"). Since claim 12 is herewith canceled, Applicants shall only address the rejection of claims 10 and 11.

With respect to the rejection of claims 10 and 11, the Examiner asserted:

[I]t would have been obvious to one of ordinary skill in the art to provide the medical device of Winkler with the *energy saving software* as taught by Davis to conserve power in that device.

In connection with combining references to support an assertion of obviousness, it is well established that the Examiner bears the burden of establishing a prima facie case of obviousness. In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention. In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). A *prima facie* case of obviousness is established only when this burden is met.

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In the case of In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), the Federal Circuit stated: "This factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority." Id. at 1434. Determination of patentability must be based on evidence, id. at 1434, and the Examiner provided none: no references pertaining to aggregation or averaging were cited, no official notice was taken, no evidence of any kind was presented. The Examiner's failure to present an evidentiary basis for the decision is clearly a legal error. Id. Assertions such as "common knowledge and common sense," even if assumed to derive from the Examiner's expertise, are not evidence, and conclusory statements do not fulfill the Examiner's obligation to make an evidentiary record. Id. at 1434-35; In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In the present instance, the Examiner has offered only such conclusory statements devoid of any recitation of the basis for the combination of Scampini and Prutchi.

If indeed the elements were known in the art, then the Examiner ought to present evidence to support that conclusion. In re Lee, 61 USPQ2d at 1435 ("[W]hen they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record."). The failure to do so renders the Examiner's rejection arbitrary, capricious and unreasonable. See id. at 1434. The Examiner may not arbitrarily, capriciously and unreasonably deny a claim by a mere declaration of obviousness without a supporting evidentiary record.

The Examiner presented no evidence of any suggestion or motivation to modify or combine either reference to arrive at the claimed invention. Nor has the Examiner presented any evidence that the recited elements are known in the art. The record consists of basically conclusory statements by the Examiner, which are not evidence and which cannot support rejections under 35 U.S.C. § 103.

However, with respect to the ground of rejection of claims 10 and 11 by combining Winkler and Davis - even assuming such a combination of prior art

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was reasonable - the combination would not provide the instantly claimed invention. That is, Davis merely describes an energy saving capability wherein an external computer processor shuts down thereby reducing energy draw from one or more batteries coupled to the processor.

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Applicant's claims 10 and 11 under 35 U.S.C. § 103(a). Withdrawal of this ground of rejection is hereby earnestly and respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that claims 1-11 of the application are in condition for allowance. An early action to that effect is courteously solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned attorney to attend to these matters.

Respectfully submitted,

Date:

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